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BELL, BOYD & LLOYD, LLP P.O. Box 1135 CHICAGO, IL 60690				ELISCA, PIERRE E
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES

6

7

8 *Ex parte* BRIAN J. REISTAD, ESWAR PRIVADARSHAN,
9 MICHAEL P. MITCHELL, JIM W. O'TOOLE, ANDREW C. PAYNE,
10 DURVAL M. VIETRA, and LARRY C. STEWART

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13 Appeal 2008-3163
14 Application 09/054,180
15 Technology Center 3600

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18 Decided: December 23, 2008

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21 *Before* ANTON W. FETTING, DAVID B. WALKER, and JOSEPH A.
22 FISCHETTI, *Administrative Patent Judges*.

23

24 FETTING, *Administrative Patent Judge*.

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27 DECISION ON APPEAL

28 STATEMENT OF THE CASE

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30 Brian J. Reistad, Eswar Privadarshan, Michael P. Mitchell, Jim W.
31 O'Toole, Andrew C. Payne, Durval M. Vietra, and Larry C. Stewart
32 (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims
33 12-36 and 39-63, the only claims pending in the application on appeal.

1 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
2 (2002).

3
4 We REVERSE.

5 The Appellants invented a way to transmit to a server computer an
6 order acceptance request that includes a plurality of terms or conditions of a
7 proposed offer for a purchase, including multiple options of at least one of
8 the terms or conditions of the offer. The server computer is programmed to
9 process the order acceptance request based on pre-programmed criteria and,
10 based on the processing of the order acceptance request, to transmit to the
11 client computer an order acceptance response that includes an amendment to
12 the proposed offer for the purchase (Specification 1:27 – 2:3).

13 An understanding of the invention can be derived from a reading of
14 exemplary claim 12, which is reproduced below [bracketed matter and some
15 paragraphing added].

16 12. An electronic commerce system comprising:
17 [1] a client computer; and
18 [2] a server computer;
19 [3] the client computer and the server computer being
20 interconnected by a public packet switched communications
21 network;
22 [4] the client computer being programmed to transmit to the
23 server computer an order acceptance request comprising a
24 plurality of terms or conditions of a proposed offer for a
25 purchase,
26 the order acceptance request comprising a discrete
27 message that includes a plurality of modular elements
28 whose individual integrity is protected by
29 embedding cryptographic security codes within
30 each of the modular elements,

at least one of the modular elements individually protected by a cryptographic security code being a digital coupon;

[5] the server computer being programmed to process the order acceptance request based on pre-programmed criteria, including authentication of the cryptographic security codes embedded within each of the modular elements and examination of the modular elements of the discrete message individually protected by the cryptographic security codes, and, based on the processing of the order acceptance request, to transmit to the client computer an order acceptance response based on the pre-programmed criteria, the order acceptance response comprising a discrete message transmitted during a negotiation phase of a transaction

that includes a plurality of modular elements whose individual integrity is protected by embedding cryptographic security codes within each of the modular elements;

[6] wherein the client computer is programmed to receive the digital coupon, protected by a cryptographic security code, from another computer.

27 This appeal arises from the Examiner's Final Rejection, mailed June
28 14, 2006. The Appellants filed an Appeal Brief in support of the appeal on
29 April 16, 2007. An Examiner's Answer to the Appeal Brief was mailed on
30 September 21, 2007. A Reply Brief was filed on November 21, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

34 Barnett US 6,321,208 B1 Nov. 20, 2001

REJECTION

2 Claims 12-36 and 39-63 stand rejected under 35 U.S.C. § 102(e) as
3 anticipated by Barnett.

ISSUE

The issue pertinent to this appeal is whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 12-36 and 39-63 under 35 U.S.C. § 102(e) as anticipated by Barnett.

9 The pertinent issue turns on whether the art applied shows an order
10 acceptance request and response that both include a plurality of modular
11 elements whose individual integrity is protected by embedding
12 cryptographic security codes within each of the modular elements.

FACTS PERTINENT TO THE ISSUES

15 The following enumerated Findings of Fact (FF) are believed to be
16 supported by a preponderance of the evidence.

Barnett

18 01. Barnett is directed to the electronic distribution of secure
19 money saving or discount coupons and other marketing
20 incentives. Barnett describes the use of a centrally located online
21 computer system for interactively distributing such coupons to
22 remotely connected consumer computers and for collecting user-
23 specific data regarding coupon usage and user demographic
24 information from the remote computers (Barnett 1:6-13).

25 02. Barnett shows a client and server interconnected by a public
26 packet switched communications network (Barnett Fig. 1).

03. Barnett describes how a user can order a package of electronic coupons from the online service provider. Commands are generated and transmitted via a data communications interface and a data link, and up to the coupon package file resident at the online service provider. The requested coupon data package and associated advertising materials are transmitted by the online service provider to the personal computer, where it is stored in the downloaded coupon data file in a coupon database (Barnett 8:22-33).

04. In addition to the usual coupon information found in prior art coupons, Barnett's coupons contain user-specific data in the form of a unique user bar code encoded with user-specific information such as the user name and/or other unique identification criteria such as a social security number or online service address. This information renders each printed coupon unique, since an otherwise similar coupon presented by a different consumer will comprise a different user bar code. This is one aspect of what Barnett refers to as the secure nature of its invention (Barnett 7:21-35).

PRINCIPLES OF LAW

Claim Construction

23 During examination of a patent application, pending claims are
24 given their broadest reasonable construction consistent with the
25 specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In*
26 *re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

1 Limitations appearing in the specification but not recited in the claim are
2 not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364,
3 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the
4 specification” without importing limitations from the specification into the
5 claims unnecessarily).

6 Although a patent applicant is entitled to be his or her own lexicographer
7 of patent claim terms, in *ex parte* prosecution it must be within limits. *In re*
8 *Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing
9 such definitions in the specification with sufficient clarity to provide a
10 person of ordinary skill in the art with clear and precise notice of the
11 meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480
12 (Fed. Cir. 1994) (although an inventor is free to define the specific terms
13 used to describe the invention, this must be done with reasonable clarity,
14 deliberateness, and precision; where an inventor chooses to give terms
15 uncommon meanings, the inventor must set out any uncommon definition in
16 some manner within the patent disclosure so as to give one of ordinary skill
17 in the art notice of the change).

18 *Anticipation*

19 "A claim is anticipated only if each and every element as set forth in
20 the claim is found, either expressly or inherently described, in a single prior
21 art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d
22 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or
23 compositions, either generically or as alternatives, the claim is deemed
24 anticipated if any of the structures or compositions within the scope of the
25 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.
26 Cir. 2001). "The identical invention must be shown in as complete detail as

1 is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d
2 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by
3 the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology
4 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

5

6 ANALYSIS

7 *Claims 12-36 and 39-63 rejected under 35 U.S.C. § 102(e) as anticipated by*
8 *Barnett.*

9 The Examiner found that Barnett described the client transmission of
10 limitation [4] during coupon request and the server processing of limitation
11 [5] at coupon redemption (Answer 3-4). Whether Barnett describes the
12 client, server and network of limitations [1]-[3] is not under contention.

13 The Appellants contend that Barnett has no description of embedding
14 cryptographic security codes within each of multiple modular elements (Br.
15 22-24); that except for a minimal reference to electronic redemption, all of
16 Barnett's described coupon redemption processing is with printed coupons,
17 negating the electronic processing of limitation [5] (Br. 24) thereby also
18 negating any description of the security codes embedded in the server
19 response of limitation [5] (Br. 24-25); and that Barnett does not describe a
20 third computer which the Appellants argue is required by limitation [6]'s
21 "another computer" (Br. 25).

22 The Examiner relied on Barnett's encoding of data into bar codes to
23 satisfy the requirements for cryptographic security codes (Answer 3-4).
24 Irrespective of whether such codes might encompass such bar codes, we do
25 not agree that Barnett describes the use of cryptographic security codes in
26 both the client transmission and server response.

1 The Examiner found that the claimed acceptance order request in
2 Barnett occurred when a coupon was requested (Answer 3: second line from
3 bottom). Since Barnett's bar code data is part of a coupon, such
4 cryptographic data would not be part of the proposed order acceptance
5 request, i.e., the coupon request. Indeed, the request for a coupon would not
6 even be a coupon as required by limitation [4]. Alternatively, if the order
7 acceptance request were the coupon transmitted by Barnett, then Barnett
8 provides no response to that request as required by limitation [5]. The
9 Examiner appears to be relying on the same portions of Barnett, column 7,
10 lines 20-55 for the cryptographic security of both the request and response.
11 This portion of Barnett describes the transmission of the coupon only, and
12 does not describe a second responsive transmission with any cryptographic
13 encoding.

14

CONCLUSIONS OF LAW

16 The art applied does not show an order acceptance request and
17 response that both include a plurality of modular elements whose individual
18 integrity is protected by embedding cryptographic security codes within each
19 of the modular elements. The Appellants have sustained their burden of
20 showing that the Examiner erred in rejecting claims 12-36 and 39-63 under
21 35 U.S.C. § 102(e) as anticipated by Barnett.

Appeal 2008-3163
Application 09/054,180

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DECISION

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To summarize, our decision is as follows:

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- The rejection of claims 12-36 and 39-63 under 35 U.S.C. § 102(e) as anticipated by Barnett is not sustained.

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REVERSED

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18 BELL, BOYD & LLOYD, LLP
19 P.O. Box 1135
20 CHICAGO, IL 60690
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